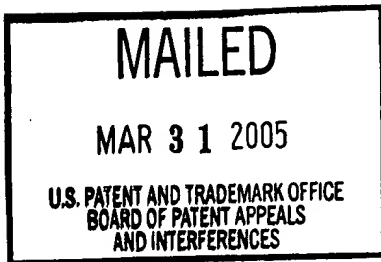


-The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte SYLVIA CHEN and
MICHAEL D. KOTZIN

Appeal No. 2005-0045
Application No. 09/801,093

ON BRIEF

Before CRAWFORD, MacDONALD, and NAPPI, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, which are all of the claims pending in this application. Claims 15 to 25 have been canceled.

The appellants' invention relates to a method that includes the step of receiving information regarding the location of a first party and a second party. The location information is used to create a schedule to automatically coordinate the activity at the destination of the first and second parties (specification, p. 5). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The references

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hall	6,026,375	Feb. 15, 2000
Hendrey	US 2002/0107008	Aug. 8, 2002

The rejections

Claims 7 to 10, 12 and 14 stand rejected under 35 U.S.C. § 102 as being anticipated by Hall.

Claims 1 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hall in view of Hendrey.

Claims 11 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hall.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 11 mailed June 15, 2004) and for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed March 10, 2004) and for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the rejection of claims 7 to 10, 12 and 14 under 35 U.S.C. § 102(b) as being anticipated by Hall. We initially note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Hall discloses a method for processing orders from customers in a mobile environment (col. 1, lines 5 to 10). A service provider receives customer location information from a location determination system and determines which local facility is closest to the location of the customer and then schedules fulfillment of an order at the local facility (col. 2, lines 41 to 48; col. 9, lines 19 to 24). The Hall method also includes the step of calculating the estimated time of arrival of the customer at the selected local facility (col. 9, lines 24 to 25). The Hall method then notifies the customer of the local facility's location and the cost of the order (col. 9, lines 51 to 53).

The examiner is of the opinion that Hall discloses each and every element of claims 7 to 10, 12 and 14. Specifically the examiner states:

. . . Hall discloses a method of notification upon arrival at a predetermined location comprising the step of: receiving a first signal indicative of a first location of a first party (Abstract, C5 L20-24; receive order and location from mobile customer); transmitting a second signal to a second party when the first location is equal to a first predetermined location (Fig 6C, C6 L21-43, Claim 2, *Claims 19-21*: transmitting the pick-up order to the service provider to be ready by the mobile customer's estimated time of arrival); and coordinating an activity at a second predetermined location based on the second signal (Abstract, C8 L1-3, Claim 5: coordinating the mobile customers ETA with food preparation).[answer at page 3]

The appellants argue that Hall does not disclose transmission of a signal when the first location of the first party is equal to a predetermined first location. We agree with the appellants and thus we will not sustain the rejection.

It is true that Hall discloses receiving a first signal indicative of a first location of a first party. Specifically, Hall discloses that the location of the customer is determined by a location determination system by receiving a signal indicative of the customer location (col. 6, lines 21 to 31). In addition, the method of Hall can repeatedly receive information about a customer's location (claim 19). The examiner reasons that Hall discloses a first predetermined location because the first location of the customer must be within the range of the system (answer at page 5). However, even if we consider the initial location of the customer to be the first predetermined location, there is still no disclosure of "transmitting a second signal to a second party when the first location is equal to a first predetermined location", as is recited in claim 7. This language of claim 7 requires the transmission of a second signal based on the first party reaching a first predetermined location which Hall simply does not disclose.

In view of the foregoing, we will not sustain the rejection of claim 7. We will likewise not sustain the rejection as it is directed to claims 8 to 10 and 12 and 14 as these claims depend from claim 7.

We turn next to the examiner's rejection of claims 1 to 6 under 35 U.S.C. 103 as being unpatentable over Hall in view of Hendrey.

Initially we note that when it is necessary in making out a rejection under 35 U.S.C. § 103, to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann

Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In the present case, the examiner recognizing that Hall does not disclose receiving a second signal that is indicative of a location of the second party, relies on Hendrey for teaching receiving a second signal indicative of a location of the second party wherein the second signal is received at the central scheduling computer. The examiner concludes:

. . . it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving a second signal indicative of a location of the second party, wherein the second signal is received at the central scheduling computer; as disclosed by Hendrey in the system disclosed by Hall, for the advantage of providing a method of coordinating an activity with the ability to increase system/method effectiveness by bringing together two mobile (phone) users.[answer at page 5]

The appellants argue that there is no suggestion to combine the teachings of Hall with the teachings of Hendrey. The appellants reason that there are significant differences between Hall and Hendrey. First, Hall has one mobile party and on stationary party and Hendrey has a number of mobile units. Second, Hall provides for scheduling so that an order from the mobile customer is processed by the time the mobile customer arrives at the local facility and Hendrey provides a telecommunication


link between two mobile units based on the location of the user. The appellants further reasons that Hall does not suggest or provide for movement of the local facility.


We agree with the appellants and thus we will not sustain this rejection as it is directed to claim 1. We will likewise not sustain this rejection as it is directed to claims 2 to 4 and 6 as each of these claims are dependent on claim 1.

We turn lastly to the rejection of claims 11 and 13 under 35 U.S.C. § 103 as being unpatentable over Hall. Claims 11 and 13 are dependent on claim 7. As we discussed above, it is our view that Hall does not disclose the limitation recited in claim 7 of transmitting a second signal when the first location is equal to a first predetermined location. In addition, it is our view that Hall does not suggest this feature. As such, we will not sustain this rejection.

The decision of the examiner is reversed.

REVERSED


MURRIEL E. CRAWFORD
Administrative Patent Judge


ALLEN R. MacDONALD
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

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